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| APPLICATION NO. | - FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|---------------|----------------------|---------------------|------------------|
| 09/787,549 | 03/20/2001 | Tomohiro Nagata | 001560-392 | 2540 |

21839 7590 07/29/2003

BURNS DOANE SWECKER & MATHIS L L P
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EXAMINER

ELISCA, PIERRE E

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
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3621

DATE MAILED: 07/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/787,549

Applicant(s)

Tomohiro Nagata et al.

Examiner

Pierre E. Elisca

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03/20/2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4 6) ☐ Other:

Serial Number: 09/787,549

Page 2

Art Unit: 3621



Examiner Pierre Eddy Elisca

United States Department of Commerce

Patent and Trademark Office

Washington, D.C. 20231

DETAILED ACTION

1. This Office action is in response to Application No. 09/787,549, filed on 03/20/2001.
2. Claims 1-18 are pending.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

4. Claims ¹⁻¹⁸~~24-33~~ are rejected under 35 U.S.C. 102 (e) as being anticipated by Collart (U.S. Pat. No. 6,405,203).

Art Unit: 3621

As per claims 1, 12-15 and 17 Collart discloses a system/method, and article of manufacture for tracking the distribution of content electronically, comprising:

provided in a product distribution environment where products are distributed through communications lines between a product provider comprising at least one of a copyright owner creating a product and a distributor distributing the product to the market and a product user receiving the product from the product provider, for exchanging copyright information relating to the product through the communications lines with both of the product provider and the product user (see., abstract, col 4, lines 28-38, col 6, lines 1-63, specifically distributor, retailer and consumer, figs 1 and 2);

the copyright information management center centrally managing all copyright information existing in the product distribution environment through the communications lines by preregistering copyright information relating to the individual products in the center (see., abstract, fig 1, col 40, lines 11-22, specifically wherein it is stated that registered users who accepted the software license agreement).

As per claims 2, 8, 9, 10, 11, 16 and 18 Collart discloses the claimed limitations of providing with a digital watermark embedding means by which at least one of the copyright owner and the distributor can embed copyright information relating to a product as digital watermark information directly in the data forming the product (see., col 31, lines 16-51, specifically wherein it is stated that watermarking enables identification and tracing of different copies of video data, col 33, lines 10-20, specifically watermarking which uniquely identifies each receiver of the signal).

Art Unit: 3621

As per claims 3, 4, 5, 6, and 7 Collart discloses the claimed limitations of providing with a digital watermark detection means for detecting the digital watermark information by the product provider and product user see., col 31, lines 16-51, specifically wherein it is stated that watermarking enables identification and tracing of different copies of video data, and detecting means see., col 32, lines 41-61, specifically watermark, if applied to individual copies of the video, may also be used to identify or detecting of the receiver of the copy, fig 5, item 550).

Conclusion

5. Any inquiry concerning this communication from the examiner should be directed to Pierre Eddy Elisca at (703) 305-3987. The examiner can normally be reached on Tuesday to Friday from 6:30AM. to 5:00PM.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of patents and Trademarks

Washington, D.C. 20231


The Official Fax Number For TC-3600 is:

(703) 305-7687

Serial Number: 09/787,549

Page 5

Art Unit: 3621


Pierre Eddy Elisca

Patent Examiner

July 24, 2003